

### REMARKS

Claims 14-17 and 27-34, as amended, and new claims 35-41 are pending in this application. In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

In particular, claims 15, 30, and 32-34 have been amended to address the Examiner's § 112 concerns. In addition, independent claims 14 and 27 have been rewritten to further clarify that the method applies to golf shoes and the particular parameters relating to the section of golf shoes. New claims 35-41 have been added to recite additional embodiments of the present invention, which are supported by the Specification at page 1, line 34 to page 2, line 1, page 7, line 23 to page 8, line 2, and page 8, lines 28-32. As no new matter has been added, Applicants respectfully request entry of these amendments at this time.

### THE REJECTIONS UNDER 35 U.S.C. § 112

The Examiner rejected claims 15, 30, and 32-34 under 35 U.S.C. § 112, second paragraph, as being indefinite. The rejected claims have been amended in a manner that is believed to address the Examiner's concerns. In light of these amendments, Applicants respectfully submit that the § 112 rejection is overcome. As such, Applicants respectfully request reconsideration and withdrawal of the rejection.

### THE REJECTIONS UNDER 35 U.S.C. §§ 102 & 103

#### *Franzene Does Not Disclose or Suggest the Present Invention*

Claims 14-17 and 27-34 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Publication No. 20002/0158358 to Franzene for the reasons provided on page 4 of the Office Action. Franzene does not anticipate or render obvious the present invention for at least the reasons that follow.

Franzene generally discloses a method of measuring a foot, creating a foot profile, transmitting the foot profile to a manufacturing station, and creating a foot mold, i.e., an insole, from the foot profile. See, e.g., page 2 at para. 0041. While the disclosure does teach a method for forming a custom insole to be used directly as a sandal, shoe sole, or within a shoe structure,

Franzene is completely silent as to the use of the method for soliciting or placing an order for golf shoes, as presently recited. As such, it follows that Franzene is also completely silent as to the features of the claimed invention that are specific to golf shoes, i.e., cleat type. In fact, Franzene's method does not include any shoe parameters outside of the size, shape, contour, or other parameters required to make a custom insole. See, e.g., page 3 at para. 0051.

Thus, Franzene does not anticipate the present invention. In addition, a skilled artisan would not have been motivated to use Franzene's method of making an insole to arrive at the present invention without using the present application as a template to pick and choose from, which is, of course, a classic case of hindsight. As such, Applicants respectfully request reconsideration and withdrawal of the § 102 rejection based thereon.

*Lee Does Not Anticipate the Present Invention*

The Examiner rejected claims 14-17 and 27-34 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Publication No. 2001/0020222 to Lee as set forth on page 4 of the Office Action. Similar to Franzene, Lee does not disclose or suggest a method of soliciting or placing an order for golf shoes, as presently recited.

Lee is directed to a custom-made footwear manufacturing system that uses foot shape information, style, fashion, and color transmitted via the internet to manufacture shoes. See, e.g., page 3, para. 0054. While Lee's system does allow for selection of parameters in addition to accounting for the foot shape, the parameters suggested relate to the shape, fashion, color, and height of the heel. See page 4, para. 0074.

In contrast, the present invention features shoe size, as well as parameters relating to golf shoes. For example, independent claim 14 recites an additional parameter selected from the group consisting of traction level, cleat type, personalization, cushioning, and combinations thereof. Likewise, the additional parameter featured in independent claim 27 is the cleat type. Lee is completely silent as to the use of the system for golf shoes and, thus, the parameters featured in claims 14 and 27 are not even suggested in the reference.

Therefore, Applicants respectfully submit that Lee does not disclose or suggest the present invention. Applicants respectfully request reconsideration and withdrawal of the present invention.

**Benson Does Not Disclose or Suggest the Present Invention**

Claims 14-17 and 27-34 were rejected under § 102(e) as anticipated by U.S. Patent No. 6,654,705 to Benson. As discussed below, Benson also does not anticipate or render obvious the present invention.

Benson generally discloses a method and apparatus for sensing the surface contour of the human foot. See Abstract. The primary thrust of the disclosure is the sensing apparatus, however, there is a brief discussion relating to the use of the digital contour information obtained from the sensing apparatus to select or manufacture shoes or shoe inserts. See, e.g., col. 2, lines 15-22 and col. 27, lines 50-63. This brief discussion does not even suggest the use of the digital contour information on golf shoes.

In addition, there is no disclosure pertaining to the selection, input, or use of another golf shoe parameter, such as the traction level, cleat type, personalization, cushioning parameters featured in independent claims 14 and 27. Furthermore, a skilled artisan would not have had any reasonable expectation of success of arriving at the present invention from the Benson disclosure absent the instant application to use as a template.

For at least the reasons discussed above, Benson does not disclose or suggest the present invention. As such, Applicants respectfully request reconsideration and withdrawal of the § 102 rejection based on Benson.

**THE INFORMATION DISCLOSURE STATEMENT**

The Examiner has requested that Applicants resubmit the Information Disclosure Statement (IDS) and references filed on October 1, 2001. Applicants submit a copy of the IDS, PTO-1449, and stamped postcard with this Response. Copies of the references are being collected and will be forwarded as soon as possible.

**CONCLUSION**

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

No fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Swidler Berlin Shereff Friedman, LLP Deposit Account No. 195127, Order No. 20004.0008.

Respectfully submitted,  
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Dated: June 30, 2004

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